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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,962	08/25/2003	Wei Zhao	9400-44	3021
39072	7590	08/25/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC, P.A.			STEIN, JULIE E	
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RALEIGH, NC 27627			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/646,962	ZHAO ET AL.	
	Examiner	Art Unit	
	Julie E. Stein, Esq.	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 10 is objected to because of the following informalities: in line 2, "a" should be deleted.
2. Claim 9 is objected to because of the following informalities: "non-communications" should be "non-communications".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is indefinite because it recites a computer program product "comprising" a computer readable medium instead of the computer program being "encoded on" the computer readable medium. In view of the originally filed specification, pages 3-4, it is unclear how a computer program can comprise a computer readable medium.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-7 and 9-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0203873 to H. Gray in view of U.S. Patent Application Publication No. 2005/0136949 to Barnes, Jr.

Gray teaches all the steps of independent claim 1, including a method for directing a mobile user to a wireless network access point (abstract) comprising:

receiving a mobile user request for a location of a wireless network access point via a user terminal (par. 35);

identifying a geographic location of the mobile user responsive to receiving the user request (par. 36); and

identifying a wireless network access point convenient to the user (par. 37).

However, Gray does not teach wherein the user request comprises non-communication amenities and that the access point convenient to the user provides access to the non-communication amenities. But, Barnes teaches in the same field of endeavor, that of mobile connectivity and information exchange (par. 6 and 10), a

mobile device (par. 28), which communicates wirelessly (see, e.g., section labeled "Communications Module", specifically pars. 38, 49 and 51, which identifies a WLAN as one type of communication system used). Barnes further teaches that the mobile device includes various application modules as described in the section so labeled beginning on paragraph 144. Various examples of these applications include determining user identified target points of interest (PI) (par. 148), which may include vendors for food, gas, goods, or public places, such as parks and restrooms (par. 151).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the user requests for non-communication amenities taught by Barnes with the method of Gray because both references are from the same field of endeavor and the wireless network access point taught in Gray is another type of PI that may be located by the mobile terminal taught in Barnes (par. 145-147 describes that any type of point of interest is contemplated).

The rejection of independent claim 1 is hereby incorporated and the same reasoning is applied to the rejection of independent claim 17. Gray also teaches all the elements of independent claim 17, including a system for directing a mobile user to a wireless network access point (abstract) comprising:

means for receiving a mobile user request for a location of a wireless network access point via a user terminal (par. 35);

means for identifying a geographic location of the mobile user responsive to receiving the user request (par. 36); and

means for identifying a wireless network access point convenient to the user (par. 37).

However, Gray does not teach the user request further comprising non-communication amenities and a wireless network access point convenient to the user that provides access to the requested non-communications amenities. But, Barnes teaches in the same field of endeavor, that of mobile connectivity and information exchange (par. 6 and 10), a mobile device (par. 28), which communicates wirelessly (see, e.g., section labeled "Communications Module", specifically pars. 38, 49 and 51, which identifies a WLAN as one type of communication system used). Barnes further teaches that the mobile device includes various application modules as described in the section so labeled beginning on paragraph 144. Various examples of these applications include determining user identified target points of interest (PI) (par. 148), which may include vendors for food, gas, goods, or public places, such as parks and restrooms (par. 151).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the user requests for non-communication amenities taught by Barnes with the system of Gray because both references are from the same field of endeavor and the wireless access point taught in Gray is another type of PI that may be located by the mobile terminal taught in Barnes (par. 145-147).

The rejections of independent claims 1 and 17 are hereby incorporated and the same reasoning is applied to the rejection of independent claim 20 (it is inherent that the various element would include computer readable code). Gray teaches all the elements

of independent claim 20, including a computer program product for directing a mobile user to a wireless network access point (abstract) the computer program product comprising:

a computer readable medium having computer readable program code embodied therein, the computer readable program code comprising:

computer readable program code that receives a mobile user request for a location of a wireless network access point via a user terminal (par. 35);

computer readable program code that identifies a geographic location of the mobile user responsive to receiving the user request (par. 36); and

computer readable program code that identifies a wireless network access point convenient to the user (par. 37).

However, Gray does not teach the user request further comprising non-communication amenities and a wireless network access point convenient to the user that provides access to the requested non-communications amenities. But, Barnes teaches in the same field of endeavor, that of mobile connectivity and information exchange (par. 6 and 10), a mobile device (par. 28), which communicates wirelessly (see, e.g., section labeled "Communications Module", specifically pars. 38, 49 and 51, which identifies a WLAN as one type of communication system used). Barnes further teaches that the mobile device includes various application modules as described in the section so labeled beginning on paragraph 144. Various examples of these applications include determining user identified target points of interest (PI) (par. 148), which may

include vendors for food, gas, goods, or public places, such as parks and restrooms (par. 151).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the user requests for non-communication amenities taught by Barnes with the system of Gray because both references are from the same field of endeavor and the wireless access point taught in Gray is another type of PI that may be located by the mobile terminal taught in Barnes (par. 145-147).

Gray in view of Barnes also teaches all the steps of dependent claim 2, including communicating the identified wireless network access point to the user. See Gray, pars. 38 to 39.

Gray in view of Barnes also teaches all the steps of dependent claim 3, including wherein identifying a geographic location of the mobile user comprises locating a wireless communications signal from the user terminal. See Gray, pars. 35 to 38.

Gray in view of Barnes also teaches all the steps of dependent claims 4, 18, and 21, including wherein identifying a wireless network access point comprises comparing the geographic location of the user to known locations of a plurality of access points. See Gray, pars. 36 to 37

Gray in view of Barnes teaches all the steps/elements of dependent claims 5, 19, and 22, including wherein identifying a wireless network access point comprises: calculating a travel time between the user location and each of the plurality of wireless network access points; and selecting one of the plurality of wireless network access points having the shortest travel time. See Gray, par. 38.

Gray teaches all the steps/elements of dependent claims 6 to 7, except wherein calculating a travel time is based on distance and road conditions and wherein the road conditions comprise real-time traffic conditions. However, Barnes teaches that once a PI is identified (from a user request (par. 151), the information is supplied to the user (par. 154) as are directions (par. 159), the closest PI (par. 156), the distance (par. 157), and any traffic delays (par. 157).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Gray with that of Barnes to achieve Applicants' claimed invention because this gives the mobile user additional information and allows the user to judge how long it will take to arrive at the location and for non-communication amenities, like food, the user may order ahead and have the food ready when they arrive. See Barnes, e.g. par. 169.

Gray teaches all the steps of claim 9 except, wherein the non-communication amenities include a type of facility and/or service available in the vicinity of the wireless network access point. But, Barnes teaches that PIs may include various types of facilities, including, for example, restaurants, gas stations, parks, etc. See Barnes, paragraph 151. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Gray with that of Barnes to achieve Applicants' claimed invention because both references are from the same field of endeavor and the wireless access point and the various non-communication amenities are just different kinds of PIs as taught by Barnes (pars. 145 to 147).

Gray teaches all the steps of claim 10 except, wherein the user request includes a particular service provider associated with the wireless network; wherein identifying a wireless network access point further comprises identifying a wireless network access point provided by the particular service provider. However, Barnes teaches the mobile terminal selecting a communication system based on availability and cost, among other parameters. Barnes, paragraphs 64 to 69. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Gray with that of Barnes to achieve Applicants' claimed invention because both references are from the same field of endeavor and as Barnes teaches, it is known to base service on a user request (par. 67) and other parameters such as cost, data transmission rates, bandwidth, and etc. (par. 65 to 66).

Gray in view of Barnes also teaches all the steps of claim 11, including further comprising communicating directions from the user location to the selected wireless network access point. See Gray, par. 38.

Gray teaches all the steps of claim 12, except communicating the information concerning non-communication amenities to the user terminal. But Barnes teaches that once a PI is identified, the information is communicated back to the mobile user. See, e.g., Figure 4. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Gray with that of Barnes to achieve Applicants' claimed invention because both references are from the same field of endeavor and as Barnes teaches this is the information that the user has requested (see, e.g., par. 160).

Gray in view of Barnes also teaches all the steps of dependent claim 13, including that the wireless network is a broadband wireless network. See Gray, par. 33.

Gray also teaches all the steps of dependent claim 14, except wherein the broadband wireless network is a Wi-Fi network. But Barnes teaches that the WLAN can be a Wi-Fi network. See par. 35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Gray with that of Barnes because both use WLAN networks in the same field of endeavor.

Gray in view of Barnes also teaches all the steps of claims 15 and 16, including wherein the user terminal is a mobile communications device or a computer processor terminal. See Gray, Figures 1-4.

### ***Response to Arguments***

8. Applicant's arguments filed May 5, 2006 have been fully considered but they are not persuasive.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., established communication link) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims currently recite “comprising” language, which is open and thus while the “mobile user request” may include non-communication amenities, it also clearly includes communication amenities—it is requesting the location of a wireless network access point.

11. As to Applicants’ argument that Barnes teaches away from selecting a communication network because it allegedly teaches automatically selecting a service provider, the Examiner responds in two ways.

12. First, the claims currently recite “comprising” language, which does not limit the manner in which the service provider is selected. The “mobile user request” recited in, for example claim 1, is being interpreted to include both manually entered and automatically entered portions, as the claimed request is via a user terminal, there is nothing currently in the claim that limits the request as coming only from a person.

13. Second, “request” is a very broad term and is being interpreted as such. For example, in Barnes, paragraph 67, “request” is used to indicate that the mobile terminal is identifying and selecting a service provider.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication Nos. 2006/0148486 to Kim et al. teaches a communication device that searches for WLAN access points and

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2004/0165563 to Hsu et al. teaches a method and apparatus for the detection and selection of WLAN service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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